

REMARKS

Reconsideration of the above-identified patent application, as amended, is respectfully requested. The present amendment is responsive to the Office Action mailed January 3, 2003. A petition for an extension of time in which to respond to the Office Action accompanies this amendment.

By the present amendment, claims 43-58 are pending in the application. Claims 43 and 44 are the independent claims.

By the present amendment, claims 1-3, 12-14 and 16-42 have been canceled without prejudice to the filing of divisional application(s) directed to non-elected inventions.

Restriction Requirement

In response to the Restriction Requirement, applicants affirm the election, with traverse, of the claims of Group I, i.e., claims 1-3, 12-14, and 22-39 and the ferrite-type stainless steel species.

Since claims 32-33 and 37-39 are directed to stainless steel species other than ferrite-type stainless steel, the applicants have effectively elected claims 1-3, 12-14, and 22-36 for further prosecution in this application.

This election is made with traverse because, although applicants maintain that all the claims are patentably distinct from one another, applicants believe

that the claims are sufficiently related to be properly presented in a single application.

This election is made without prejudice to the filing of a divisional application(s) directed to the non elected invention.

Possible Rejoinder

The applicants request the Examiner to consider possible rejoinder of the austenite-type stainless steel species and the two-phase-type stainless steel species to the elected claims of Group I if the elected claims are deemed patentable regardless of the stainless steel used, i.e., if a generic type stainless steel would be deemed patentable.

Support For Claims

New claims 43-58 of the present amendment correspond to elected claims 2-3, 12-14 and 22-36, i.e., the claims of Group I restricted to the ferrite-type stainless steel species.

Claims 43 & 44

New independent claims 43 and 44 correspond to original independent claims 2 and 3. The phrase "mainly comprising" has been changed to --consisting essentially of--. The resin composition has been limited to --(A) a resin composition consisting of only a soluble polyurethane resin composition ...--.

New independent claims 43 and 44 have been restricted to the --ferrite-type stainless steel sheet--.

New independent claims 43 and 44 have the additional limitation --wherein the soluble lubricating resin film is removed from the stainless steel sheet after the soluble lubricating surface-treated stainless steel sheet is shaped--. Support for this limitation may be found in the specification, e.g., at page 19, line 28 to page 20, line 32.

Claims 45 & 46

New dependent claims 45 and 46 correspond to prior dependent claims 22 and 23. The last two lines of these claims have been rewritten to read --has an acid value of 30 to 180-- in order to improve clarity.

Claims 47 & 48

New dependent claims 47 and 48 correspond to prior dependent claims 24 and 25. In claims 47 and 48, the term "the neutralizer" has been changed to --a neutralizer--.

Claims 49 & 50

New dependent claims 49 and 50 correspond to prior dependent claims 26 and 27. The term "the main component" has been changed to --a component--.

Claims 51 & 52

New dependent claims 51 and 52 correspond to prior dependent claims 28 and 29. The term "the main component" has been changed to --a component--.

Claims 53 & 54

New dependent claims 53 and 54 correspond to prior dependent claims 30 and 31.

Claims 55 & 56

New dependent claims 55 and 56 correspond to prior dependent claims 35 and 36.

Claims 57 & 58

New dependent claims 57 and 58 correspond to original dependent claim 13.

New matter is not being presented by the present amendment.

§112, ¶2

Claims 13 and 24 to 29 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

By the present amendment, claims 13 and 24 to 29 have been canceled. This rejection, as applied to the claims of the present amendment, is respectfully traversed.

With regard to claim 13, claim 13 has been canceled and replaced with new claims 57 and 58 which depend from new claims 55 and 56.

With regard to claims 24 and 25, claims 24 and 25 have been canceled and replaced with new claims 47 and 48 wherein the term "the neutralizer" has been changed to "a neutralizer".

With regard to claims 26 to 29, claims 26 to 29 have been canceled and replaced with new claims 49 to 52 wherein the term "main component" has been changed to --a component--.

In view of the present amendment, it is respectfully requested that the rejection under 35 U.S.C. §112, second paragraph, be withdrawn.

Claim Interpretation

With regard to claims 2 and 3, claims 2 and 3 have been canceled and replaced with new independent claims 43 and 44. In new independent claims 43 and 44 the phrase "mainly comprising" has been changed to --consisting essentially of--.

With regard to claims 22 and 23, claims 22 and 23 have been canceled and replaced with new claims 45 and 46. New claims 45 and 46 use the phrase --has an acid value from 30 to 180--.

§103

Claims 1-3, 13, 22-23, 26-31 and 34-36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Katsushi et al. in view of Hirata et al.

Claims 1-3, 22-23, 26-31 and 34-36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Katsushi et al. in view of Bohnke et al.

Claims 1-3, 13, 22-31 and 34-36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ryoji et al. in view of Hirata et al.

Claims 1-3, 22-31 and 34-36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ryoji et al. in view of Bohnke et al.

These rejections, as applied to new claims 43-58, are respectfully traversed.

Patentability

As described in the specification, the resin of the soluble lubricating resin film of the present invention consists essentially of the soluble polyurethane resin composition (A), which is suitable to form a soluble lubricating resin film. By using the soluble lubricating resin film of the present invention, excellent lubrication and protection during even deep drawing or squeezing can be obtained. The soluble lubricating resin film of the present invention is removed from the stainless steel sheet after shaping of the stainless steel sheet.

Katsushi et al.

Katsushi et al. clearly mentions that the film is a non-defilm (not-removed film) in the abstract and in paragraphs (0004) and (0005). The purpose of the film is to provide chemical and corrosion resistances to steel sheet being used. That is, the film remains on the surface of the steel sheet after the steel sheet is worked or shaped and when the shaped steel sheet is being used.

Katsushi et al. discloses an insoluble lubricating resin film comprising a mixture of a urethane resin and an epoxy resin. The composition of the resin is different from that of the present invention which does not contain the epoxy resin.

Thus, Katsushi et al. is essentially different from the present invention and the present invention is not disclosed or suggested by Katsushi et al.

Ryoji et al.

Ryoji et al. does not directly mention that the film is a non-defilm (not-removed film), but it is clear that the film is a non-defilm (not-removed film) since Ryoji et al. describes that the purpose of the film is to provide chemical and corrosion resistances to steel sheet. The purpose of the film of the present invention is to provide an excellent lubrication during deep shaping, and chemical and corrosion resistances are not required by the present invention since the film is removed after the shaping.

The assignee of Katsushi et al. and Ryoji et al. as well as the present application is the same, Nippon Steel Corporation. Therefore the present inventors known that Katsushi et al. and Ryoji et al. are directed to a non-defilm (not-removed film).

The composition of the film in Ryoji et al. is very similar to that of Katsushi et al., and different from that of the present invention. Further, the inventors, Katsushi Saito and Toshiyuki Katsumi, are common in Katsushi et al. and Ryoji et al. The difference between Katsushi et al. and Ryoji et al. resides in presence or absence of the chemical conversion treatment of the surface of the steel sheet under the non-defilm.

The purpose and the constitution of the invention of Ryoji et al. are thus different from those of the present invention.

Ryoji et al. is essentially different from the present invention and the present invention is not disclosed or suggested by Ryoji et al.

Hirata et al. and Bohnke et al.

Hirata et al. and Bohnke et al. do not disclose the lubrication treatment of the present invention.

Therefore, even if Katsushi et al. and Ryoji et al. are combined with Hirata et al. and Bohnke et al., the present invention is not disclosed or suggested by the combination.

It is submitted that the present invention, as defined in independent claims 43 and 44, and all claims dependent thereon, is not disclosed or suggested by Katsushi et al., Ryoji et al., Hirata et al., and/or Bohnke et al. standing alone or in any combination.

It is therefore submitted that claims 43-58 of the present amendment are patentable.

CONCLUSION

In view of the present amendment and the foregoing remarks, it is submitted that the application is now in condition for allowance. It is therefore respectfully requested that the application, as amended, be allowed and passed for issue.

Respectfully submitted,

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